

Notice of Allowability

Application No.

10/632,531

Applicant(s)

HAYASHI ET AL.

Examiner

Zachary C. Tucker

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1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6 March 2006.
2. ☒ The allowed claim(s) is/are 15-17 and 20-25.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date ____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date ____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other ____

JAMES O. WILSON**SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**

Response to Amendment

As requested in the correspondence filed by applicants on 6 March 2006 (hereinafter "present amendment"), which is in reply to the Non-Final Rejection mailed 6 September 2005 (hereinafter "previous Office action"), claims 15, 20 and 25 have been amended and claims 18 and 19 have been cancelled.

Status of Claim Rejections - 35 USC § 112

In the previous Office action, claims 15-25 were rejected under the second paragraph of 35 U.S.C. 112, for being of indefinite scope.

The rejection under this statute of instant claims 18 and 19 is rendered moot by the cancellation of those two claims pursuant to the present amendment; the rejection of claims 15-17 and 20-25 under 35 U.S.C. 112, second paragraph, on all grounds, is hereby withdrawn in view of the present amendment to claim 15, 20 and 25.

Specifically, the claim limitation "optionally substituted" which modifies the various structural variables in claim 15 has now been characterized with a specific Markush group from which the optional substituent is to be selected, the proviso which was deemed to be self-contradictory has been struck from instant claim 15, the compound "t-butyl-dehydrophenylahistin" has been struck from instant claim 25, and applicants' counsel has kindly pointed out the definitions for KPU-11 and KPU-66 in the specification.

Status of Claim Rejections - 35 USC § 102

In the previous Office action, claims 15-17, 19 and 22 were rejected under 35 U.S.C. 102(b) as being anticipated by Augustin, M. *Journal für Praktische Chemie*, vol. 32(4), pages 158-166 (1966).

In view of the cancellation of claim 19, the rejection of that claim is rendered moot. In view of the present amendment to instant claim 15, which now requires structural variable R₄ in Formula (I) to be in all cases a *t*-butyl group, the rejections based on Augustin are hereby withdrawn. Augustin does not disclose or suggest any *t*-butyl-substituted compound.

In the previous Office action, claims 15, 17, 18, 19 and 22 were rejected under 35 U.S.C. 102(b) as being anticipated by Küster and Köppenhofer, *Z. Physiol. Chem.*, vol. 172, pages 126-137 (1927).

Since claims 18 and 19 have been cancelled by the present amendment, the rejection of those two claims under this statute is rendered moot.

In view of the amendment to instant claim 15, which now requires R₄ in Formula (I) to be in all cases *t*-butyl, the rejection based on Küster and Köppenhofer is hereby withdrawn. The Küster and Köppenhofer reference does not teach or suggest any *t*-butyl-substituted compound.

In the previous Office action, claims 15-17, 18, 19 and 22-24 were rejected as being anticipated by CA 2 403 790 (Kanzaki et al).

Cancellation of claims 18 and 19 has rendered the rejection of those two claims as being anticipated by Kanzaki et al moot.

The rejection of claims 15-17 and 22-24 as being anticipated by Kanzaki et al is hereby withdrawn in view of the present amendment to instant claim 15, which requires

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R₄ to be *t*-butyl in all cases. Kanzaki et al does not disclose any *t*-butyl-substituted compound.

Status of Claim Rejections - 35 USC § 103

In the previous Office action, claims 19 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable (obvious) over CA 2 403 790 (Kanzaki et al).

Claim 19 has been cancelled pursuant to the present amendment, so the rejection of that claim as being obvious over Kanzaki et al is moot.

Co-inventor Yoshio Hayashi has filed a Declaration under 37 C.F.R. 1.132, in which it is shown that *t*-butyl phenylahistin is more than ten times as potent than *n*-butyl phenylahistin, insofar as the cytotoxicity of compounds is concerned (P388 cells). This is considered an unexpected result in view of the teaching of the Kanzaki et al patent, as it includes no suggestion of any potency gain which might be realized by substituting *t*-butyl for *n*-butyl at the position corresponding to R₄ in the compounds of that patent.

Therefore, the rejection under 35 U.S.C. 103(a), based on Kanzaki et al, is hereby withdrawn.

Allowable Subject Matter

Claims 15-17 and 20-25 are allowed.

The following is an examiner's statement of reasons for allowance:

All previously stated rejections have been overcome by applicants' present amendment, and by the Declaration under 37 C.F.R. 1.132, made by co-inventor Yoshio Hayashi. The closest prior art, which was summarized in the previous Office action at pages 12 and 13, does not teach or suggest any compound embraced by the instant claims as amended pursuant to the correspondence from applicants filed 6 March 2006.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion


All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

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